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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,284

08/29/2005

Walter Keller

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7590

09/30/2009

THE MAXHAM FIRM

9330 SCRANTON ROAD, SUITE 350

SAN DIEGO, CA 92121

EXAMINER

NOORISTANY, SULAIMAN

ART UNIT

PAPER NUMBER

2446

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,284	<b>Applicant(s)</b> KELLER, WALTER	
	<b>Examiner</b> SULAIMAN NOORISTANY	<b>Art Unit</b> 2446	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/18/2005, 12/08/2005</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

***Detailed Action***

The notice of abandonment mailed on 9-22-09 was in error and is hereby vacated.

This Office Action is response to the application (10/528284) filed on 12/18/2008.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

***Claims 13-16 are rejected under 112, second paragraph as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention***

In claims 13-16, “*all executable programs sent as attachments to e-mails are automatically separated in the JMB*” is indefinite and not clear what this is in reference to (e.g., there is no correlation between claim 9 and 13). However, the claims will be given a broad reasonable interpretation for the purposes of examination as best understood.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 9-16, 25-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fleming**. US Patent No. **6,249,805** in view of **Sundsted** U.S. Patent No. **US 5,999,967**.

**Regarding claim 9**, Fleming teaches wherein a method to automatically handle undesired electronic mail (e-mail) in communication networks at the receiver, the method comprising:

automatically comparing the sender address accompanying an incoming e-mail to an electronically accessed list of authorized sender addresses assigned to the receiver (**Fig. 1, unit 106 – authorization component**); and then

storing the e-mail in a mailbox MB of the recipient (**Fig. 2, unit 205 – store selected Email in inbox folder**), wherein the only e-mails transferred to the receiver's mailbox are those that had clearly been sent by authorized senders (**Fig. 2, unit 204 – retrieved ID in authorized list**).

With respect to claim 9, Fleming teaches the invention set forth above except for the claimed “*in combination with*:

*performing an analysis to see if there is serial, incremental user identification occurring so that conclusions can be drawn concerning automatic attempts at breaking into the e-mail system.”*

Sundsted teaches that is well known to utilize filtering the receiving emails in combination with performing an analysis to see if there is serial, incremental user identification occurring so that conclusions can be drawn concerning automatic attempts

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at breaking into the e-mail system (**Fig. 3A, unit 23 – Analysis Module; Fig. 4, unit 40 - serial field**).

Thus, the manner of enhancing method for filtering unauthorized electronic mail messages that are sent by senders to a user where the system includes a list of the identifications of the senders who are authorized to send an electronic mail message to the user. When an electronic mail message is received, the system determines whether the sender of the electronic mail message is authorized by determining whether the identification of sender in the electronic mail message is in the list of the identifications of the senders who are authorized. When the sender of the electronic mail message is determined to be authorized, the system stores the electronic mail message in an Inbox folder. When the sender of the electronic mail message is determined to be not authorized, the system stores the electronic mail message in a Junk Mail folder. In this way, the electronic ail messages are automatically stored in the appropriate folder based on whether the sender is authorized so that the user can view the Inbox folder containing the electronic mail messages sent by authorized senders separately from the Junk Mail folder containing the electronic mail messages sent by unauthorized senders by Fleming, was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in a method which allows the receiver of electronic mail to make a decision to accept, reject, prioritize, or expedite delivery of a piece of electronic mail based on the value of an attached electronic stamp. Whereas the method consists of two complimentary parts: a sender side part with responsibility for attaching the electronic stamp; and a receiver side part with responsibility for

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removing the electronic stamp and filtering the electronic mail based on the value of the electronic stamp. The method is used in a system for reducing or eliminating the amount of junk electronic mail in the electronic mail system by Sundsted. Accordingly, one of ordinary skill in the art would have been capable of applying this known “improvement” technique in the same manner to the prior art Fleming and the results would have been predictable to one of ordinary skill in the art, namely, one skilled in the art would have readily recognized that advantages based on the teachings of Sundsted.

**Regarding claim 10**, Fleming and Sundsted together taught the method according as in claim 9 above. Fleming further teaches wherein there are two logically or physically, or both, separate mailboxes, said mailbox MB (**inbox folder**) and a junk mailbox JMB (**Junk Mail folder**), wherein the e-mail server sends to the JMB mailbox all incoming e-mails that indeed have the subscriber's correct recipient address but are not contained in the sender list on the receiving side (**If the retrieved ID does not match, than the authorization component stores the intercepted electronic mail message in a pre-designated location, such as a Junk Mail folder – Col. 4, lines 24-27**), thus making them available for further processing selectively by the internet service provider, the administrative authorities, and by the recipient (**periodically, the user can view the Junk mail folder to delete or read (means further processing) the electronic messages that we designed as junk – Col. 4, lines 34-36**).

**Regarding claims 11-12**, Fleming and Sundsted together taught the method according

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as in claim 9 above. Fleming further teaches wherein the incoming e-mails are selectively put through an automatic handling and analysis process (**The authorization component intercepts electronic mail messages that are sent to a user before they are placed in the user's Inbox folder—Col. 4, lines 15-17**), which can be selectively configured by the recipient and by the ISP (**forwards the electronic mail message to the recipient via a communications mechanism such as a local area network or the Internet – Col. 1, lines 18-20**), selectively in the e-mail server, in a comparison device (**various computer systems – Col. 1, lines 35**), and in at least one of the mailboxes (**Inbox folder or Junk Mail folder**), said process initiated and configured either on a case-by-case basis or permanently (**Fig. 3**).

Sundsted further teaches wherein the incoming e-mails are selectively put through an automatic handling and analysis process, which can be selectively configured by the recipient and by the ISP, selectively in the e-mail server, in a comparison device, and in at least one of the mailboxes, said process initiated and configured either on a case-by-case basis or permanently (**Procmail – Col. 1, lines 30-41**).

**Claims 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fleming**. US Patent No. **6,249,805** in view of **Sundsted** U.S. Patent No. **US 5,999,967** further in view of **Shipp** US Patent App. No. **US 20040054498**.

**Regarding claims 13-16**, Fleming and Sundsted together taught the method according

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as in claim 9 above. However, Fleming and Sundsted are silent in term “*wherein all executable programs sent as attachments to e-mails are automatically separated*”

**Shipp** teaches that it is well known to have system wherein all executable programs sent as attachments to e-mails are automatically separated **(the attachment must contain some executable element to be viewed as a potential threat ....– [0104-0105; 0134-0137])**.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming's and Sundsted's invention by a component normally considered as an attachment: These may be directly executable, such as an EXE file. They may contain embedded executable code, such as a Microsoft Word document containing a macro. They may contain archive file or other container files, which themselves may contain other dangerous components. For instance, a ZIP file may contain an executable. In addition, the system is capable of being toggled into a mode where it views all attachments as a potential threat disposing of the infected emails without sending them to their addressed recipients. Holding them in temporary storage “**here is same JMB**” and notifying the addressee by email that an infected message has been intercepted and is being held for a period for their retrieval, should they wish, otherwise it will be deleted

**Regarding claims 25-28**, Fleming and Sundsted together taught the method according as in claim 9 above. Fleming further teaches wherein the contents of the JMB can be cyclically deleted at specific time intervals **(Periodically, the user can view the Junk**



**Mail folder to delete or read the electronic mail messages that were designated as junk – Col. 4, lines 33-36).**

**Claims 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over

**Fleming**. US Patent No. **6,249,805** in view of **Sundsted** U.S. Patent No. **US 5,999,967** further in view of **Weeks** US Patent App. No. **US 20040054733**.

**Regarding claims 17- 20**, Fleming and Sundsted together taught the method according as in claim 9 above. However, Fleming and Sundstead are silent in terms of “wherein if an undesired e-mail is received, discontinuation requests, or cease and desist demands, can be generated automatically and delivered to the sender”.

Weeks teaches that it is well known to have a method “wherein if an undesired e-mail is received, discontinuation requests, or cease and desist demands, can be generated automatically and delivered to the sender” (**FIGS. 4-9 provide flow diagrams illustrating exemplary processes implemented in the e-mail management system 10 of FIG. 1. – [0011-0016]**) in order to make the system more efficient and that prevent delivery of unsolicited e-mail are known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming's and Sundsted's invention by utilizing a system wherein after reviewing the e-mail stored in the inbox folder 102, the user may determine that an e-mail is an unsolicited e-mail and thus may desire to prevent delivery of further email from the sender of the unsolicited e-mail. To do so, the user selects the

unsolicited e-mail and places it in the e-mail stop folder 104. The system 10 then automatically generates stop data 106 based on the unsolicited e-mail stored in the e-mail stop folder 104 to prevent delivery of any further e-mail sent to the user address from the sender, as taught by Weeks [0019].

**Claims 21-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fleming**. US Patent No. **6,249,805** in view of **Sundsted** U.S. Patent No. **US 5,999,967** further in view of **Lalonde** US Patent No. **US 7,072,944** further in view of **Shipp** US Patent App. No. **US 20040054498**

**Regarding claims 21-24**, Fleming and Sundsted together taught the method according as in claim 9 above. However Fleming and Sundsted are silent in terms of "*wherein virus checks of the e-mail can be carried out selectively at an established time of day or each time a message arrives.*"

Lalonde teaches that it is well known to have "wherein virus checks of the e-mail can be carried out selectively at an established time of day or each time a message arrives" (**Fig. 9, unit 174 – virus check**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming's and Sundsted's invention by utilizing virus system in which it solves the major problems of ensuring that the emails are handled in an efficient and timely manner in the email engine. The application is typically provided on a client machine (e.g. PCs) and communicates with a mail server so that, when the

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client machine receives email from the mail server, the client plug-in authenticates the email as described herein. Thus, each time the virus protection application checks an email for a virus, it also authenticates the email to obtain an authentication indicator which informs a user of the likelihood of the email being spoofed (as taught by Lalonde).

### ***Response to Arguments***

#### **Applicant Argument:**

1. An incremental change of the electronic stamp serial number is not an incremental change in an identification of the sender, even though the electronic stamp serial number is sent with the Sender Address Field and the Signature Field, because the identification of the sender that is provided by the Sender Address Field and the Signature Field is not changed.

#### **Examiner Response**

With respect to applicant argument, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Sundsted discloses in Fig. 3, an Analysis Module 23 connected to Decryption Module 22. Analysis Module 23 validates the electronic stamp. It also decides whether to accept, reject, or otherwise handle electronic mail based on the value of its electronic stamp and A Preferences Record 24 connected to Analysis Module 23. Preferences Record 24 holds user preferences. In particular, it holds the amount of compensation the sender desires for each piece of

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electronic mail received. Analysis Module 23 uses this information when deciding how to handle electronic mail. A History Log 25 connected to Analysis Module 23. History Log 25 holds previously received electronic stamps for record-keeping. Sundsted further discloses in Fig. 4, a Serial Number Field 40. Serial Number Field 40 holds the serial number of the electronic stamp. This number is issued by the sending system. A serial number must never be reissued. The simplest serial number generator is a counter that is incremented for each electronic stamp generated. Therefore, examiner maintains the rejection.

**Applicant Argument:**

2. Each time a particular sender sends a new message with a new electronic stamp, there is an incremental change in the electronic stamp serial number. But it is only when a particular sender sends a series of successive emails to the same email receiver that the electronic stamp of the email received by said mailbox changes incrementally. Such an incremental change in the electronic stamp serial number of successively received emails is in accordance with an authorized use of the system, whereby the detection of such an incremental change cannot be used to draw a conclusion concerning automatic attempts at breaking into the e-mail system, as required by claim 9.

**Examiner Response**

With respect to applicant argument, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Sundsted discloses in Fig. 3, an

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Analysis Module 23 read the serial number from Serial Number Field 40. It then checks History Log 25 to see if this electronic stamp has been received before. If the electronic stamp is found in History Log 25, this is a good indication that the electronic mail has been delivered multiple times, either due to a fault in the electronic mail system or due to malicious intent. In either case, the electronic stamp and the associated electronic mail should be rejected and the results are used in a system for eliminating the amount of junk electronic mail in the electronic mail system. Therefore, examiner maintains the rejection.

**Applicant Argument:**

3. Sundsted does not disclose that the identification number held by the Identification Field 46 is changed incrementally; and Sundsted neither discloses nor suggests any reason for incrementally changing the identification number held by the Identification Field 46.

**Examiner Response**

With respect to applicant argument, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Sundsted discloses in Fig. 3, an Analysis Module 23 an Analysis Module 23 read the serial number from Serial Number Field 40. It then checks History Log 25 to see if this electronic stamp has been received before. If the electronic stamp is found in History Log 25, this is a good indication that the electronic mail has been delivered multiple times, either due to a fault in the

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electronic mail system or due to malicious intent. In either case, the electronic stamp and the associated electronic mail should be rejected and the results are used in a system for eliminating the amount of junk electronic mail in the electronic mail system. Therefore, examiner maintains the rejection.

**Applicant Argument:**

4. Sundsted does not disclose that the digital signature from Signature Field 47 is changed incrementally; and Sundsted neither discloses nor suggests any reason for incrementally changing the digital signature.

**Examiner Response**

With respect to applicant argument, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Sundsted discloses in Fig. 4, a Serial Number Field 40. Serial Number Field 40 holds the serial number of the electronic stamp. This number is issued by the sending system. A serial number must never be reissued. The simplest serial number generator is a counter that is incremented for each electronic stamp generated. Therefore, examiner maintains the rejection.

**Applicant Argument:**

5. Even though the serial numbers of the electronic stamps issued by a particular sender in Sundsted's system change incrementally as they are being issued, Sundsted neither discloses nor suggests analyzing the serial numbers of the received electronic

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stamps to see if the serial numbers are changing incrementally.

### **Examiner Response**

With respect to applicant argument, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Sundsted discloses in Fig. 4, a Serial Number Field 40. Serial Number Field 40 holds the serial number of the electronic stamp. This number is issued by the sending system. A serial number must never be reissued. The simplest serial number generator is a counter that is incremented for each electronic stamp generated. Identification Field 46 holds the identification number of the sending system. Each sending system will be issued a unique identification number. Signature Field 47 holds the digital signature of the electronic stamp. The digital signature may be computed using any secure digital signature algorithm. Once it assembles the values in Serial Number Field 40, Value Field 41, Date Field 42, Hash Field 43, Receiver Address Field 44, Sender Address Field 45, and Identification Field 46, the sending system generates the digital signature of the electronic stamp and signs the electronic stamp with it. Without this digital signature, a malicious party could forge an electronic stamp claiming to be from any sender in the electronic mail system. Therefore, examiner maintains the rejection.

### **Applicant Argument:**

6. Sundsted's analysis of the serial number of an electronic stamp that accompanies a message currently received by the email receiver is a comparison of the currently

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received electronic stamp serial number with serial numbers in a history log 25 of the electronic stamps that accompanied email messages previously sent by the same sender to the particular email receiver. Such comparison is not an analysis to see if there is "serial, incremental user identification occurring," as required by claim 9.

### **Examiner Response**

With respect to applicant argument, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Sundsted discloses in Fig. 3, in step (g) Analysis Module reads the serial number from Serial Number Field 40. It then checks History Log 25 to see if this electronic stamp has been received before. If the electronic stamp is found in History Log 25, this is a good indication that the electronic mail has been delivered multiple times, either due to a fault in the electronic mail system or due to malicious intent. In either case, the electronic stamp and the associated electronic mail should be rejected. Therefore, examiner maintains the rejection.

Applicant's arguments with respect to claim(s) 13-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SULAIMAN NOORISTANY whose telephone number is (571)270-1929. The examiner can normally be reached on Monday Through Friday



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9:30 am to 5:00 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Pwu can be reached on 571-272-6798.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**Sulaiman Nooristany 05/18/2009**

**/Jeffrey Pwu/**

**Supervisory Patent Examiner, Art Unit 2446**